REMARKS / ARGUMENTS

Status of the claims

Claims 1, 6, 18-20 and 24-25 have been examined and have been rejected solely under 35 U.S.C. §103 (a).

Claims 1, 6, 18-19 and 24-25 have been rejected under 35 U.S.C. §103 (a) as allegedly unpatentable over U.S. Patent No. 5,690,933 (Cobbold) taken with U.S. Patent No. 6,306,820 (Bendele). In addition, Claim 20 has been rejected as allegedly unpatentable over the Cobbold patent, in view of the Bendele patent, and further in view of Owens et al. (1994).

Applicants traverse these rejections on the following grounds.

Patent '933 teaches inducing tolerance by administering CD4 and CD8 mAbs, non-depleting or depleting and non-depleting. At column 3, lines 31-34 of the patent, it is described that "a CD11a mAb, a non-depleting mAb, may be used in addition to CD4 and CD8 mAbs or in place of either or both of the CD4 or CD8 mAbs." Column 3 mentions that long term specific tolerance can be induced to treat autoimmune disease such as rheumatoid arthritis [lines 51-55]. Claim 1 of Cobbold is directed to a method of treating an autoimmune disorder by administration of a non-depleting anti-CD4 mAb. Claim 4 which depends from only claim 1, claims rheumatoid arthritis as an autoimmune disorder. Claims 2 and 3 describe further administering an immunosuppressive agent.

The Cobbold patent fails to specifically disclose a method of treating rheumatoid arthritis with an anti-CD11a antibody and an immunosuppressive agent let alone a TNF-α antagonist that is a TNF-α receptor - IgG Fc fusion protein as recited in the present claims. As discussed previously, the Bendele '820 patent fails to teach or suggest any anti-LFA-1 antagonist let alone anti-CD11a antibody in combination therapy with a TNF-α antagonist in a method of treating RA. The known description of ENBREL alone does not render accomplish the method of the claimed invention.

Without some suggestion in the cited references to modify or combine the teachings of the references, the Office has not established a prima facie case of obviousness. See, e.g., In ACS Hospital Systems v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) wherein the Court of Appeals for the Federal Circuit stated that:

> "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so."

Obviousness cannot be predicated on hindsight reconstruction of the invention using the Applicant's disclosure as a guide. In re Geiger, 2 U.S.P.Q.2d 1277, 1278 (Fed. Cir. 1987).

Now turning to the rejection of claim 20 over the Cobbold and the Bendele patents and the Owens reference, this rejection is traversed on at least the same grounds as given in the preceding rejection. The inadequacies of the teachings of the Cobbold and Bendele patents have been discussed above. The Owens reference while discussing humanized antibodies does not overcome the inadequacies of the teachings of Cobbold and Bendele to achieve the claimed invention.

From the above discussion, the cited references alone, or in combination, fail to specifically suggest the specific combination of agents for the treatment of rheumatoid arthritis as claimed. Therefore, the claimed invention cannot be obvious. It is submitted that the Examiner has failed his burden of establishing prima facie obviousness of the rejected claims. Applicants respectfully submit that all of the §103 rejections have clearly been overcome and request that they be withdrawn.

CONCLUSION

Applicants submit that the above discussion is fully responsive to all grounds of rejection set forth in the Office Action. In view of the comments above, Applicants respectfully request that all outstanding rejections be withdrawn, and that the pending claims be allowed. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If a telephone interview would be of assistance in advancing prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Assistant Commissioner to

charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 07-0630 (Ref. Docket No. P1795R1).

Respectfully submitted,
GENENTECH, INC.

Date: March 12, 2004

By: Lee Tan

Lee K. Tan, Ph.D.
Reg. No. 39,447
Telephone: (650)225-4462

Document #141899